

REMARKS

In view of the above amendment and the following remarks, the Examiner is requested to allow claims 1-10, 13-15, 22, and 24-29, as well as newly presented Claims 30-31, the only claims pending and under examination in this application.

The above amendments and new claims find support throughout the application as originally filed. No new matter has been added. As the above amendment places the application in better form for consideration on appeal, entry thereof is respectfully requested.

Claim Rejections – 35 U.S.C. § 101

Claims 1-10, 22, and 24-28 were rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed.

With respect to rejections under 35 U.S.C. 101, the USTPO Official Gazette Notice dated 22 November 2005, entitled "*Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*" ("the OG Notice") contains guidelines for patent examiners. Review of these guidelines in the OG notice indicates that the Examiner's rejection of claims 17-28 and 45-68 fails to comply with the guidelines provided in the OG Notice.

Section IV of the OG Notice explains, in detail, the procedures to be followed to determine whether a claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. § 101. The only references to "tangible results" in this procedure appear under Step IV(C) – "*Determine Whether the Claimed Invention Falls Within Sec. 101 Judicial Exceptions – Laws of Nature, Natural Phenomena and Abstract Ideas.*" Not surprisingly, the first thing the Examiner must do under Step IV(C) is to "*determine whether [a claim] covers either a Sec. 101 judicial exception.*" Only if such a determination is made, does the analysis then proceed to determine if

the claimed subject matter is nevertheless still patentable subject matter as a practical application of a Sec. 101 judicial exception, for example, because: (1) the claim provides a physical transformation (Step IV(C)(1)(a)); or (2) the claims produces a useful, concrete, and tangible result (Step IV(C)(1)(b)).

In the Office's communications to date, it is not seen where the Examiner has even attempted to determine whether any or all of claims 1-10, 22, and 24-28 cover a Sec. 101 judicial exception (Law of Nature, Natural Phenomenon, or Abstract Idea). Rather, the Examiner concluded that Applicant's claims are drawn to a judicial exception with no analysis or explanation supporting this position, and directly imposed the criteria for a practical application of a Sec. 101 judicial exception, wherein the Examiner stated that the claims and the process claimed need to either have physical transformation and/or useful, concrete and tangible results. Applying the criteria for a practical application of a Sec. 101 judicial exception to Applicant's claims, without first establishing that Applicant's claims are drawn to a judicial exception, amounts to a failure to comply with the above-referenced examination guidelines.

Applicant submits that none of claims 1-10, 22, and 24-28 are drawn to a judicial exception because these claims do not cover a law of nature, natural phenomenon, or abstract idea. Claims 1-10, 22, and 24-28 are directed toward methods of identifying a sequent of a nucleic acid for use as a probe on an array. It is clear that these claims do not cover any law of nature or natural phenomenon. Further, it is clear from the recited tangible, non-abstract elements of Applicant's claims, that claims 1-10, 22, and 24-28 are not directed to an abstract idea. Accordingly, the entire analysis as to where the claims "*provide physical transformation*" and/or "*produce a tangible result*" is not even pertinent under the above-referenced examination guidelines, because the claims are not directed to any Sec. 101 judicial exception in the first place. The Examiner's rejection under 35 U.S.C. §101 fails to comply with the examination guidelines and should be withdrawn on this ground.

Furthermore, even if any of claims 1-10, 22, and 24-28 were directed to a Sec. 101 judicial exception, which they are clearly not, the OG Notice defines "tangible" as being the opposite of "abstract." All that is required is that the claim must set forth a practical application to produce a real-world result. Here, the claims all are practical applications producing the real-world result of selecting a sequence for use as a substrate immobilized probe. The claims all include tangible and concrete steps of receiving an array scanner, retrieving data and accessing a program. Accordingly, assuming arguendo that claims 1-10, 22, and 24-28 were directed to a Sec. 101 judicial exception, the final result at the very least is a tangible result.

Therefore, Applicants' claimed invention is drawn to statutory subject matter. Withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 102

Claims 1-10, 13-15, 22 and 24-29 were all rejected under 35 U.S.C. §112, second paragraph. In view of the above amendments to Claims 1, 22 and 24, it is believed that this rejection may be withdrawn.

Claim Rejections – 35 U.S.C. § 103(a)

Claims 1-10, 13-15, 22 and 24-29 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Leproust in view of Tomiuk.

With respect to Leproust being available as prior art under 35 U.S.C § 103, MPEP § 706.02(l)(1) states:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102 (e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. This change to 35 U.S.C. 103(c) applies to all utility, design

and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues."

The present application claims priority to October 30, 2003. Leproust was not published until April 22, 2004. As such, Leproust only qualifies as prior art to the present application under 35 USC §102 (e).

Thus, if the Leproust publication and the instant application were owned by the same person or subject to an obligation of assignment to the same person, at the time the instant application was made, the Leproust publication is disqualified as prior art under 35 USC §102 (e) and therefore cannot preclude patentability under §103.

This is indeed the case. The invention claimed in the instant patent application was subject to an obligation of assignment to Agilent Technologies. An assignment executed by the inventors was recorded on April 19, 2004 (Reel/Frame 014531/0464).

The Leproust patent cited as art was owned by Agilent Technologies at the time the claimed invention in that patent was made, as evidenced by an assignment by the listed inventors to Agilent Technologies, recorded on February 17, 2004 (Reel/Frame 014345/0683).

As can be seen in view of these two assignments, the subject matter of the cited Leproust publication and the presently claimed invention were, at the time the invention was made, both owned by Agilent or both under an obligation of assignment to Agilent. As such, in accordance with §103(c), the Leproust publication shall not preclude patentability under §103.

Therefore, the Leproust publication is not available as prior art against the claimed invention of the present application under §102 (e). The claims thus cannot

be rejected under § 103 (a) by a combination that relies upon the disclosure of
Leproust

Withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Bret Field at (650) 327-3400.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10030416-1.

Respectfully submitted,

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